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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/762,517

Applicant(s)

MORITZEN, KLAUS

Examiner

C. Aaron McIntyre

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-14,16-18,20-45,47-60,62-90,103 and 104 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44,45,47-59,80 and 81 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-14,16-18,20-43,60,62-79,82-90,103 and 104 is/are rejected.
- 7) ☒ Claim(s) 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination (“RCE”) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants’ submission received on 04 December 2009 has been entered.

Acknowledgements

2. This non-final Office action responds to the amendment and arguments received from Applicants on 04 December 2009 (claims) and 16 September 2009 (remarks) in reply to the previous Office action on the merits, mailed 20 July 2009.
3. Claims 1-3, 5-14, 16-18, 20-45, 47-60, 62-90, 103, and 104 are pending.
4. Claims 1-3, 5-14, 16-18, 20-45, 47-60, 62-90, 103, and 104 have been examined.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and MPEP §2181 IV. and its discussion of 37 C.F.R. §1.75(d)(1). Correction or appropriate clarification of the following claim limitations is required:

- a. “means for examining licensing information” as recited in claim 60.

- b. “means for comparing information identifying a machine” in claim 60.
 - c. “means for determining a number of uses” in claim 60.
 - d. “means for granting the license for use” in claim 60.
 - e. “means for examining validity of the software license” in claim 60.
 - f. “means for prohibiting at least one of operation...” in claim 62.
6. The Examiner has reviewed the cited paragraphs [0047-0048] discussed in Applicants’ September 2009 Remarks and does not find there to be proper antecedent basis for the claimed subject matter.

Claim Objections

7. Claim 44 is objected to because of the following informalities: It appears that “entering into a stored file, date, time of day and identity of the designated machine for each use of the software” was intended to be -- entering into a stored file the date, time of day and identity of the designated machine for each use of the software --, which change will be assumed for purposes of further consideration of the claims, as to the merits, herein below. Appropriate correction or clarification is required.

Claim Rejections - 35 USC § 112, First Paragraph

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 30-43, 78-79, 83-90, and 104 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

g. Claim 30 recites the limitation “preventing unauthorized change of information” which does not necessarily have support from the original specification and is therefore considered new matter. Applicants have support for “protect against any unauthorized change of any information” via ¶ [0033] of the specification which recites “protect any unauthorized change of any information.” In short, the specification has support for “protecting against” but does not support “preventing.”

h. Claim 104 recites the limitation “preventing replacement of a license file” which does not necessarily have support from the original specification and is therefore considered new matter. Applicants have support for “detecting an attempt to replace a license file” via ¶¶ [0036-0038] of the specification which recites “the attempt to replace a license file, this can be detected...”

Claim Rejections - 35 USC § 112, Second Paragraph

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 60, 62-74, and 82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Regarding claim 60, the claimed element “means for examining licensing information” is a means plus function limitation that invokes 35 U.S.C. §112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.

13. In particular, while the Examiner finds it to be evident that a general computing device is performing this function, the written description fails to link or associate how the device is performing this function such as what algorithm is used. See *Blackboard Inc. v. Desire2Learn Inc.*, 91 USPQ2d 1481 (Fed. Cir. 2009), pp. 1491-1492.

14. Applicant is required to:

(a) Amend the claim so the claim limitation will no longer include a means plus function limitation under 35 U.S.C. §112, sixth paragraph; or

(b) Amend the written description of the specification to clearly link or associate the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. §132(a)).

15. In addition, the following claimed elements have similar if not identical problems as discussed immediately above with regard to a lack of a particular corresponding structure from the specification:

- i. “means for comparing information identifying a machine” in claim 60.
- j. “means for determining a number of uses” in claim 60.
- k. “means for granting the license for use” in claim 60.
- l. “means for examining validity of the software license” in claim 60.
- m. “means for prohibiting at least one of operation...” in claim 62.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-3, 5-14, 16-18, 20-43, 60, 62-79, 82-90, 103, and 104 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2004/0205261 to Osada in view of U.S. Patent No. 6,708,157 to Stefik et al., hereinafter referred to as Stefik, in further view of U.S. Patent No. 6,816,842 to Singh et al., hereinafter referred to as Singh.

18. Claims 30-43, 78-79, 83-90, and 103 are additionally rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2004/0205261 to Osada in view of U.S. Patent No. 6,708,157 to Stefik et al., hereinafter referred to as Stefik.

19. The Examiner has maintained the groupings of the dependent claims for brevity. In short, Singh is not needed for claims 30-43, 78-79, 83-90, and 103. Each and every patentably distinct claim element has been addressed in the most efficient manner possible.

20. Regarding **claims 1 and 16**, Osada discloses a licensing method, system, and computer readable medium ("*license management module*" [abstract]), comprising:

21. storing licensing information ("*FIG. 11 is a diagram showing part of the contents of licensing conditions*" [0040]; [fig. 11]) on a storage device ("*DISK 204*" [fig. 2]; "*the license information stored in the RAM 202 or the DISK 204 in the step S1405 on the image forming apparatus 100*" [0108]) in the user machine ("*image forming apparatus 100 (MFP) is comprised of a controller 101*" [0058]; [fig. 1]), the licensing information ("*licensing*" [0040]) including at least one use ("*Total Print Surface Count*" [fig. 11]) of software ("*software of the controller 101*" [0070]; [fig. 1]) on the user machine ([fig. 1]), the information being unique and unchangeable information identifying the machine ("*data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100*" [0088]; [fig. 11]; "*apparatus identification information 800*" [0083]; [fig. 9]), information for measuring a number of uses of the software on the machine ("*The total print surface count 84 is license information indicative of the total number of print surfaces that can be used*" [0080]; [fig.

8]; *"Total Print Surface Count 1005"* [fig. 11]) and information for validating a license to the software (*"screen 1303 is an error termination screen displayed when the process ends in failure, and on the screen are displayed a message 'The designated license is invalid.'"* [0105]);

locally granting a license (*"acquires license information"* [0013]; *"transmitting the license information inputted by the operation of the operator"* [0016]) for the number of uses (*"Total Print Surface Count 1005"* [fig. 11]) of the software (*"software of the controller 101"* [0070]; [fig. 1]) on the user machine (*"image forming apparatus 100"* [0058]; [fig. 1]), based upon the stored information (*"storage device that holds the license information"* [0015]; *"license information"* [0016]),

wherein the device/second code segment (*"License Management Module 503"* [0121]; [fig. 5]) is further adapted to cause the computer to check validity (*"determine whether the process can be started"* [0121]; *"step S1502 whether or not the decryption has been successfully performed"* [0112]; *"The designated license is invalid."* [0105]) of the software license (*"license information 905 is passed to the license management module 503"* [0086]; *"step S1502 whether or not the decryption has been successfully performed"* [0112]) during at least one of start-up and shut-down of the machine (*"Each of all the program modules managed by the start program management data table 600 requests the license management module 503, before starting a process that uses resources, to determine whether the process can be started"* [0121]; [fig. 20]).

22. Additionally regarding **claim 1**, Osada discloses a storage medium (*"a storage medium"* [0012]) and a device in the machine for locally granting a license (*"License Management Module 503"* [fig. 5]);

23. Additionally regarding **claims 16**, Osada discloses a first code segment (“*Used Resources Totalizing Module 504*” [fig. 5]) and a second code segment (“*License Management Module 503*” [fig. 5]);

24. But Osada does not explicitly disclose prepaid (*although logically it appears to be prepaid*) and checking validity based on an encrypted checksum.

25. However, Stefik teaches prepaid (“*A ticket is an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service*” [col. 3, ll. 58-67 – col. 4, ll. 1-10]).

26. And Singh teaches checking validity based on an encrypted checksum (“*generates a checksum value, which is later encrypted to form part of a digital signature for the license file ... checksum value contains information that locks the use of the license to the particular diagnostic system*” [col. 11, ll. 6-23]).

27. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included prepaid, in accordance with the teaching of Stefik, in order to increase profits by allowing payment in advance of use as well as decreasing administrative expenses associated with billing.

28. And it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included checking validity based on an encrypted checksum, in accordance with the teaching of Singh, in order to increase security of the license by using the encrypted checksum to lock the use of the license to a particular machine as taught by Singh ([col. 11, ll. 6-23]).

29. Regarding **claim 30**, Osada discloses a licensing method, system, and computer readable medium (“*license management module*” [abstract]), comprising:

30. storing licensing information (“*FIG. 11 is a diagram showing part of the contents of licensing conditions*” [0040]; [fig. 11]) on a storage device (“*DISK 204*” [fig. 2]; “*the license information stored in the RAM 202 or the DISK 204 in the step S1405 on the image forming apparatus 100*” [0108]) in the user machine (“*image forming apparatus 100 (MFP) is comprised of a controller 101*” [0058]; [fig. 1]), the licensing information (“*licensing*” [0040]) including at least one use (“*Total Print Surface Count*” [fig. 11]) of software (“*software of the controller 101*” [0070]; [fig. 1]) on the user machine ([fig. 1]), the information being unique and unchangeable information identifying the machine (“*data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100*” [0088]; [fig. 11]; “*apparatus identification information 800*” [0083]; [fig. 9]), information for measuring a number of uses of the software on the machine (“*The total print surface count 84 is license information indicative of the total number of print surfaces that can be used*” [0080]; [fig. 8]; “*Total Print Surface Count 1005*” [fig. 11]) and information for validating a license to the software (“*screen 1303 is an error termination screen displayed when the process ends in failure, and on the screen are displayed a message ‘The designated license is invalid.’*” [0105]); locally granting a license (“*acquires license information*” [0013]; “*transmitting the license information inputted by the operation of the operator*” [0016]) for the number of uses (“*Total Print Surface Count 1005*” [fig. 11]) of the software (“*software of the controller 101*” [0070]; [fig. 1]) on the user machine (“*image forming apparatus 100*” [0058]; [fig. 1]), based

upon the stored information (“*storage device that holds the license information*” [0015]; “*license information*” [0016]); and

31. But Osada does not explicitly disclose prepaid (*although logically it appears to be prepaid*) and preventing unauthorized change of information relating to the granting of the license.

32. However, Stefik teaches prepaid (“*A ticket is an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service*” [col. 3, ll. 58-67 – col. 4, ll. 1-10]) and preventing unauthorized change of information relating to the granting of the license (“*decrypts the digital certificate ... decrypts the software*” [col. 42, ll. 15-53]).

33. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included prepaid and preventing unauthorized change of information relating to the granting of the license, in accordance with the teaching of Stefik, in order to increase profits by allowing payment in advance of use as well as decreasing administrative expenses associated with billing and to increase security by using both encryption and a tamper-checking code thereby preventing unauthorized change.

34. Regarding **claims 2, 17, and 31**, Osada discloses wherein the step of locally granting the license (“*FIG. 20 is a flowchart of a determination process executed by the license management module*” [0049]; [fig. 20]; [fig. 5]) includes counting a number of uses of the software on the machine (“*it is determined in a step S1905 whether or not the total print surface count has exceeded its limit*” [0124]; [fig. 20]; [0049]).

35. Regarding **claims 3, 18, and 32**, Osada discloses prohibiting at least one of operation of the software (“*abnormal termination*” [0129]) and operation of the machine using the software (“*abnormal termination*” [0129]), with respect to the license (“*limit*” [0124]), upon the count reaching [a limit] (“*it is determined in a step S1905 whether or not the total print surface count has exceeded its limit*” [0124]; *step S1905 and “Error Termination” step S1910* [fig. 20]).

36. But Osada does not explicitly disclose the limit being zero.

37. However, it is admitted prior art that a limit could be zero because often systems count down instead of up.

38. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included a limit of zero, in accordance with the admitted prior art, in order to provide an alternative system with the ability to count down instead of counting up.

39. Regarding **claim 33**, Osada discloses checking/examining validity of the software license during at least one of start-up and shut-down of the machine (“*Each of all the program modules managed by the start program management data table 600 requests the license management module 503, before starting a process that uses resources, to determine whether the process can be started*” [0121]; [fig. 20]).

40. But Osada does not explicitly disclose checking validity based on an encrypted checksum.

41. However, Singh teaches checking validity based on an encrypted checksum (“*generates a checksum value, which is later encrypted to form part of a digital signature for the license file ... checksum value contains information that locks the use of the license to the particular diagnostic system*” [col. 11, ll. 6-23]).

42. Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included checking validity based on an encrypted checksum, in accordance with the teaching of Singh, in order to increase security of the license by using the encrypted checksum to lock the use of the license to a particular machine as taught by Singh ([col. 11, ll. 6-23]).

43. Regarding **claims 5, 7, 20, 22, 34, and 36**, Osada discloses wherein the step of locally granting the license includes comparing the stored unique and unchangeable information to actual information identifying the machine on which the software will be used (“*when the apparatus specifying information included in the license information acquired by the license information acquisition device and the apparatus identification information stored in the storage device match*” [0013]; [0083]).

44. Regarding **claims 6, 8, 21, 23, 35, 37, and 62**, Osada discloses prohibiting at least one of operation of the software (“*abnormal termination*” [0129]; “*Error Termination S1508*” [fig. 16]) and operation of the machine using the software (“*abnormal termination*” [0129]; “*Error Termination S1508*” [fig. 16]), with respect to the license (“*limit*” [0124]), upon determining that the comparison does not match (“*Apparatus ID’s Match? S1503*” [fig. 16]; [0112]).

45. Regarding **claims 9, 10, 11, 24, 25, 26, 38, 39, 40, 63, and 64**, Osada discloses wherein at least a portion of the stored information is encrypted (“*Preferably, the license information comprises encrypted information*” [0023]).

46. Regarding **claims 12, 13, 14, 27, 28, 29, 41, 42, 43, and 65**, Osada discloses as discussed above. But Osada does not explicitly disclose wherein the machine is a medical device.

47. However, Singh teaches wherein the machine is a medical device (“*medical imaging equipment*” [col. 1, ll. 13-25]).

48. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included wherein the machine is a medical device, in accordance with the teaching of Singh, in order to increase profits by providing a wider range of computer devices upon which the licensing method could be implemented.

49. Regarding **claim 60**, Osada discloses a method, apparatus, and computer readable medium for granting a license on a machine (“*license management module*” [abstract]; [fig. 1]; [fig. 5]), comprising:

examining licensing information (“*license management device comprising a license information holding device that holds the license information associated with each of programs set to a program to be executed at the start of the image forming apparatus*” which it examines [0021-0022]) on a designated machine (“*image forming apparatus*” [0021]), the licensing

information including information on a use of software (*“license information associated with each of programs”* [0021-0022]), including a number of uses of the software (*“usage limit”* [0022]; [fig. 11]) and unique and unchangeable information identifying the designated machine (*“apparatus identification information 800”* [0083]; *“Serial Number 1001”* [fig. 11]);

comparing (*“match”* [0013]) information identifying a machine to the unique and unchangeable information identifying the designated machine (*“when the apparatus specifying information included in the license information acquired by the license information acquisition device and the apparatus identification information stored in the storage device match”* [0013]; *“apparatus identification information 800”* [0083]; *“data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100”* [0088]; [fig. 11]; [fig. 9]);

determining (*“determining”* [0124]) a number of uses of the software on the machine and comparing the number of uses to the number of [limited] uses (*“it is determined in a step S1905 whether or not the total print surface count has exceeded its limit. This determination is carried out by comparing the total print surface count 84 associated with the relevant module ID in the management information 80 with the total print surface count 1802 associated with the relevant module ID in the used resources totalizing table 1800 held by the used resources totalizing module 504, and determining, based on the result of the comparison, whether or not the total print surface count has exceeded its limit”* [0124]; [fig. 20]; [0049]);

granting the license (*“acquires license information”* [0013]; *“transmitting the license information inputted by the operation of the operator”* [0016]) for use (*“Total Print Surface Count 1005”* [fig. 11]) of the software (*“software of the controller 101”* [0070]; [fig. 1]) on the

machine (“*image forming apparatus 100*” [0058]; [fig. 1]) for the number of uses remaining (difference between “*total print surface count 84*” and “*total print surface count 1802*” [0124]) upon the information identifying the machine matching (“*match*” [0013]) the unique and unchangeable information identifying the designated machine (“*data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100*” [0088]; [fig. 11]; [fig. 9]) and upon the number of uses being determined to be less than the number of prepaid uses (“*determining*” [0124]; *S1905* [fig. 20]; “*Normal Termination S1908*” [fig. 20]);

examining validity (“*determine whether the process can be started*” [0121]; “*step S1502 whether or not the decryption has been successfully performed*” [0112]; “*The designated license is invalid.*” [0105]) of the software license (“*license information 905 is passed to the license management module 503*” [0086]; “*step S1502 whether or not the decryption has been successfully performed*” [0112]) during at least one of start-up and shut-down of the machine (“*Each of all the program modules managed by the start program management data table 600 requests the license management module 503, before starting a process that uses resources, to determine whether the process can be started*” [0121]; [fig. 20]).

50. But Osada does not explicitly disclose prepaid (*although logically it appears to be prepaid*) and checking validity based on an encrypted checksum.

51. However, Stefik teaches prepaid (“*A ticket is an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service*” [col. 3, ll. 58-67 – col. 4, ll. 1-10]).

52. And Singh teaches checking validity based on an encrypted checksum (“*generates a checksum value, which is later encrypted to form part of a digital signature for the license file ... checksum value contains information that locks the use of the license to the particular diagnostic system*” [col. 11, ll. 6-23]).

53. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included prepaid, in accordance with the teaching of Stefik, in order to increase profits by allowing payment in advance of use as well as decreasing administrative expenses associated with billing.

54. And it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included checking validity based on an encrypted checksum, in accordance with the teaching of Singh, in order to increase security of the license by using the encrypted checksum to lock the use of the license to a particular machine as taught by Singh ([col. 11, ll. 6-23]).

55. Regarding **claims 66, and 84**, Osada discloses determining a number (“*the result of the comparison*” [0124]) of uses of the software remaining (“*whether or not the total print surface count has exceeded its limit*” [0124]).

56. Regarding **claims 67, and 85**, Osada discloses determining a number (“*the result of the comparison*” [0124]) of uses of the software remaining (“*whether or not the total print surface count has exceeded its limit*” [0124]) and indicating (“*status indicative*” [0128]) the number of remaining uses on the machine (“*notification of used resources and the used resources totalizing*

table" [0118]; *when there are no remaining uses, "a status indicative of abnormal termination of the present process is set in a step S1910"* [0128]; [fig. 20]).

57. Regarding **claims 68, and 86**, Osada discloses determining a number ("*the result of the comparison*" [0124]) of uses of the software remaining ("*whether or not the total print surface count has exceeded its limit*" [0124]) and providing an indication on the machine ("*status indicative of abnormal termination*" [0128]) upon determining that the number of remaining uses exceeds a threshold ("*when there are no remaining uses, "a status indicative of abnormal termination of the present process is set in a step S1910"*" [0128]; [fig. 20]).

58. Regarding **claims 69, 70, 87, and 89**, Osada discloses wherein the indication includes a visual indication ("*FIG. 14A or the screen 1303 shown in FIG. 14B is displayed according to the result of the process*" [0105]; [figs. 14A-14B]; "*status line 1140*" [0100]; "You Can Copy" "1 Sheet(s)" [fig. 12]).

59. Although it is the Examiner's principle position that Osada discloses a visual indication, if it is not clear enough then the Examiner's alternative position is that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included displaying this information in the status line, in accordance with the further teachings of Osada, in order to provide greater functionality by providing the user with an indication of the status.

60. Regarding **claims 71, 72, 73, 74, 88, and 90**, Osada discloses as discussed above. But Osada does not explicitly disclose wherein the indication includes an audible indication.

61. However, it is admitted prior art to use audible indications or alerts.

62. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included wherein the indication includes an audible indications, in accordance with the admitted prior art, in order to increase the audience capable of using the device, such as to a visually impaired person who cannot easily see the tiny display in Osada..

63. Regarding **claims 75, 77, 78, and 82**, Osada discloses wherein the information on storage medium is a software option ("*when the option is a software one*" [0007]; "*license management device*" [0013]).

64. Regarding **claim 76, 79, and 83**, Osada discloses wherein the storage medium stores both the software and the software option ("*storage device that stores ... a plurality of programs ... and a license management device that permits use of the plurality of programs*" [0013]).

65. Regarding **claim 103**, Osada discloses a licensing method, system, and computer readable medium ("*license management module*" [abstract]), comprising:

storing licensing information ("*FIG. 11 is a diagram showing part of the contents of licensing conditions*" [0040]; [fig. 11]) on a storage device ("*DISK 204*" [fig. 2]; "*the license information stored in the RAM 202 or the DISK 204 in the step S1405 on the image forming*

apparatus 100" [0108]) in the user machine ("image forming apparatus 100 (MFP) is comprised of a controller 101" [0058]; [fig. 1]), the licensing information ("licensing" [0040]) including at least one use ("Total Print Surface Count" [fig. 11]) of software ("software of the controller 101" [0070]; [fig. 1]) to be licensed ("license management device that permits use of the plurality of programs" [0013]; [fig. 1]) on the user machine ([fig. 1]), the information being unique and unchangeable information identifying the machine ("data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100" [0088]; [fig. 11]; "apparatus identification information 800" [0083]; [fig. 9]), information for measuring a number of uses of the software to be licensed ("license management device that permits use of the plurality of programs" [0013]; [fig. 1]) on the machine ("The total print surface count 84 is license information indicative of the total number of print surfaces that can be used" [0080]; [fig. 8]; "Total Print Surface Count 1005" [fig. 11]) and information for validating a license to the software ("screen 1303 is an error termination screen displayed when the process ends in failure, and on the screen are displayed a message 'The designated license is invalid.'" [0105]); and

locally granting a license ("acquires license information" [0013]; "transmitting the license information inputted by the operation of the operator" [0016]) for the number of uses ("Total Print Surface Count 1005" [fig. 11]) of the software ("software of the controller 101" [0070]; [fig. 1]) to be licensed ("license management device that permits use of the plurality of programs" [0013]; [fig. 1]) on the user machine ("image forming apparatus 100" [0058]; [fig. 1]), based upon the stored information ("storage device that holds the license information" [0015]; "license information" [0016]).

66. But Osada does not explicitly disclose prepaid (*although logically it appears to be prepaid*) and encrypting the software to be licensed so as to protect against an unauthorized use of the software.

67. However, Stefik teaches prepaid (*"A ticket is an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service"* [col. 3, ll. 58-67 – col. 4, ll. 1-10]) and encrypting the software (*"digital work 509 ... data in the contents file may be compressed (for saving storage) or encrypted (for security)"* [col. 9, ll. 27-42]; [fig. 5]; *"digital works (e.g. software programs)"* [col. 8, ll. 52-67]) to be licensed so as to protect against an unauthorized use of the software (*"encrypted (for security)"* [col. 9, ll. 27-42]).

68. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included prepaid and encrypting the software to be licensed so as to protect against an unauthorized use of the software, in accordance with the teaching of Stefik, in order to increase profits by allowing payment in advance of use as well as decreasing administrative expenses associated with billing and to increase security by encrypting the software thereby protecting against unauthorized use.

69. Regarding **claim 104**, Osada discloses a method, apparatus, and computer readable medium for granting a license on a machine (*"license management module"* [abstract]; [fig. 1]; [fig. 5]), comprising:

examining licensing information (*"license management device comprising a license information holding device that holds the license information associated with each of programs set to a program to be executed at the start of the image forming apparatus"* which it examines

[0021-0022]) on a designated machine (“*image forming apparatus*” [0021]), the licensing information including information on a use of software (“*license information associated with each of programs*” [0021-0022]), including a number of uses of the software (“*usage limit*” [0022]; [fig. 11]) and unique and unchangeable information identifying the designated machine (“*apparatus identification information 800*” [0083]; “*Serial Number 1001*” [fig. 11]);

comparing (“*match*” [0013]) information identifying a machine to the unique and unchangeable information (“*when the apparatus specifying information included in the license information acquired by the license information acquisition device and the apparatus identification information stored in the storage device match*” [0013]; “*apparatus identification information 800*” [0083]; “*data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100*” [0088]; [fig. 11]; [fig. 9]) stored on a storage device (“*DISK 204*” [fig. 2]; “*the license information stored in the RAM 202 or the DISK 204 in the step S1405 on the image forming apparatus 100*” [0108]);

determining (“*determining*” [0124]) a number of uses of the software on the machine and comparing the number of uses to the number of [limited] uses (“*it is determined in a step S1905 whether or not the total print surface count has exceeded its limit. This determination is carried out by comparing the total print surface count 84 associated with the relevant module ID in the management information 80 with the total print surface count 1802 associated with the relevant module ID in the used resources totalizing table 1800 held by the used resources totalizing module 504, and determining, based on the result of the comparison, whether or not the total print surface count has exceeded its limit*” [0124]; [fig. 20]; [0049]);

granting the license (“*acquires license information*” [0013]; “*transmitting the license information inputted by the operation of the operator*” [0016]) for use (“*Total Print Surface Count 1005*” [fig. 11]) of the software (“*software of the controller 101*” [0070]; [fig. 1]) on the machine (“*image forming apparatus 100*” [0058]; [fig. 1]) for the number of uses remaining (difference between “*total print surface count 84*” and “*total print surface count 1802*” [0124]) upon the information identifying the machine matching (“*match*” [0013]) the unique and unchangeable information identifying the designated machine (“*data item 1001 stores the serial number. The serial number is information for uniquely specifying the image forming apparatus 100*” [0088]; [fig. 11]; [fig. 9]) and upon the number of uses being determined to be less than the number of prepaid uses (“*determining*” [0124]; *S1905* [fig. 20]; “*Normal Termination S1908*” [fig. 20]); and

70. But Osada does not explicitly disclose prepaid (*although logically it appears to be prepaid*) and preventing replacement of a license file.

71. However, Stefik teaches prepaid (“*A ticket is an indicator that the ticket holder has already paid for or is otherwise entitled to some specified right, product or service*” [col. 3, ll. 58-67 – col. 4, ll. 1-10]).

72. And Singh teaches preventing replacement of a license file (“*generates a checksum value, which is later encrypted to form part of a digital signature for the license file ... checksum value contains information that locks the use of the license to the particular diagnostic system*” [col. 11, ll. 6-23]).

73. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included prepaid, in accordance

with the teaching of Stefik, in order to increase profits by allowing payment in advance of use as well as decreasing administrative expenses associated with billing.

74. And it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Osada so as to have included preventing replacement of a license file, in accordance with the teaching of Singh, in order to increase security of the license by using the encrypted checksum to lock the use of the license to a particular machine as taught by Singh ([col. 11, ll. 6-23]).

75. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision.

35 USC § 112 6th Paragraph

Means Phrase #1

76. The Examiner concludes that the phrase “means for examining licensing information” in claim 60 (“Means Phrase #1”) invokes 35 U.S.C. § 112 6th paragraph.

- a. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #1 meets Invocation Prong (A) because “means for” is recited.
- b. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #1 meets Invocation Prong (B) because the phrase recites the function of “examining licensing information.” This function will have its ordinary and plain meaning.

c. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #1 meets Invocation Prong (C) because the claim does *not* recite sufficient definite structure for performing the function of “examining licensing information.”

Means Phrase #2

77. The Examiner concludes that the phrase “means for comparing information” in claim 60 (“Means Phrase #2”) invokes 35 U.S.C. § 112 6th paragraph.

a. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #2 meets Invocation Prong (A) because “means for” is recited.

b. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #2 meets Invocation Prong (B) because the phrase recites the function of “comparing information.” This function will have its ordinary and plain meaning.

c. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #2 meets Invocation Prong (C) because the claim does *not* recite sufficient definite structure for performing the function of “comparing information.”

Means Phrase #3

78. The Examiner concludes that the phrase “means for determining a number of uses” in claim 60 (“Means Phrase #3”) invokes 35 U.S.C. § 112 6th paragraph.

a. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #3 meets Invocation Prong (A) because “means for” is recited.

- b. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #3 meets Invocation Prong (B) because the phrase recites the function of “determining a number of uses.” This function will have its ordinary and plain meaning.
- c. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #3 meets Invocation Prong (C) because the claim does *not* recite sufficient definite structure for performing the function of “determining a number of uses.”

Means Phrase #4

79. The Examiner concludes that the phrase “means for granting the license” in claim 60 (“Means Phrase #4”) invokes 35 U.S.C. § 112 6th paragraph.

- a. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #4 meets Invocation Prong (A) because “means for” is recited.
- b. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #4 meets Invocation Prong (B) because the phrase recites the function of “granting the license.” This function will have its ordinary and plain meaning.
- c. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #4 meets Invocation Prong (C) because the claim does *not* recite sufficient definite structure for performing the function of “granting the license.”

Means Phrase #5

80. The Examiner concludes that the phrase “means for examining validity” in claim 60 (“Means Phrase #5”) invokes 35 U.S.C. § 112 6th paragraph.

- a. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #5 meets Invocation Prong (A) because “means for” is recited.
- b. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #5 meets Invocation Prong (B) because the phrase recites the function of “examining validity.” This function will have its ordinary and plain meaning.
- c. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #5 meets Invocation Prong (C) because the claim does *not* recite sufficient definite structure for performing the function of “examining validity.”

Means Phrase #6

81. The Examiner concludes that the phrase “means for prohibiting at least one of operation...” in claim 62 (“Means Phrase #6”) invokes 35 U.S.C. § 112 6th paragraph.
- a. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #6 meets Invocation Prong (A) because “means for” is recited.
 - b. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #6 meets Invocation Prong (B) because the phrase recites the function of “prohibiting at least one of operation....” This function will have its ordinary and plain meaning.
 - c. In accordance with MPEP § 2181 I., the Examiner concludes Means Phrase #6 meets Invocation Prong (C) because the claim does *not* recite sufficient definite structure for performing the function of “prohibiting at least one of operation....”

Allowable Subject Matter

82. Claims 44-45, 47-59, and 80-81 are allowable over the prior art. There is one claim objection pending regarding claim 44.

Response to Arguments

83. Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

Conclusion

84. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to C. Aaron McIntyre whose telephone number is (571) 270-5401. The Examiner can normally be reached on Monday to Friday 9-6 ET.

85. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

86. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. Aaron McIntyre/
Examiner, Art Unit 3621
March 11, 2010

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621